

SUPPORT FOR THE AMENDMENTS

Claim 11 is canceled herein.

Claim 12 has been amended.

Claim 13 has been added.

The amendment of Claim 12 and the addition of new Claim 13 is supported by original Claim 12 and by the specification at, for example, page 13, lines 16-20.

No new matter has been added by the present amendments.

REMARKS

Claims 1-10, 12, and 13 are pending in the present application.

The rejections of: (a) Claims 1-6, 11, and 12 under 35 U.S.C. §103(a) over Barsa (US 4,540,781) in view of Bechara et al (US 4,4040,992), and (b) Claims 7-10 under 35 U.S.C. §103(a) over Barsa (US 4,540,781) in view of Bechara et al (US 4,4040,992) and further in view of Brandt et al (US 5,489,663) is respectfully traversed.

The Examiner is reminded that MPEP 2142 states:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), amended, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. The initial evaluation of *prima facie* obviousness thus relieves both the examiner and applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to render obvious the claimed invention.

In the present application, the Examiner has not met this initial burden. Specifically, in the outstanding Office Action the Examiner has not established where in the cited references, and upon what basis, the artisan would envision a carboxylic acid salt as a catalyst bearing a hydroxyl group in the α -position relative to the carboxylic acid group in Barsa and Bechara et al.

Moreover, Applicants direct the Examiner's attention to the Examples of the present application, which clearly demonstrate that the α -hydroxyl carboxylic acids give rise to polyisocyanates with a lower color number. Specific reference is made to the following comparisons:

Example 1 vs. Comparative Example 1

Example 4 vs. Comparative Example 2

Example 5 vs. Comparative Example 3

Applicants submit that the results demonstrated in these comparisons clearly illustrate that, even if a *prima facie* case of obviousness can be established, Applicants demonstration is sufficient to rebut the same.

In view of the foregoing, withdrawal of these grounds of rejection is requested.

The rejections of Claims 11 and 12 under: (a) 35 U.S.C. §101 and (b) 35 U.S.C. §112, are obviated by amendment.

Claim 11 has been canceled and Claim 12 has been rewritten to be in proper product form.

Withdrawal of these grounds of rejection is requested.

Application Serial No. 10/589,659
Response to Office Action mailed October 29, 2008

Applicants submit that the present application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)